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10/760,075	01/18/2004	Frederic Fortin	09955.0047-01000	1916
22852	7590	05/26/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3775	
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			05/26/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/760,075

**Applicant(s)**

FORTIN ET AL.

**Examiner**

Nicholas Woodall

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)  
Paper No(s)/Mail Date 02/18/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 02/18/2009.

#### *Election/Restrictions*

2. Newly submitted claims 21-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus, since the process as claimed does not require the apparatus as claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. The examiner would like to note that this application is a continuation of the PCT application and not a national stage continuation of the PCT application. Therefore, the current application falls under the U.S. restriction guidelines. This restriction requirement is **FINAL**.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

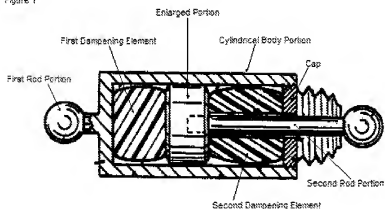
4. Claims 13-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674).

Regarding claim 13, Navas discloses a device comprising a cylindrical body portion, a first rod portion, a second rod portion, a first dampening member, and a second dampening member (see Figure 1 below). The cylindrical body includes a first end and a second end. The first rod portion extends from the first end of the cylindrical body in a first direction. The second rod portion includes a first elongated body and an enlarged end portion, wherein the enlarged end portion is positioned within the cylindrical body portion and the first elongated body extends in a second direction opposite the first direction and passes through an opening in the second end of the cylindrical portion. The first dampening member is positioned between the enlarged end portion and the first end of the cylindrical body. The second dampening member is positioned between the enlarged end portion and the second end of the cylindrical body. Regarding claim 14, Navas discloses a device wherein the second end of the cylindrical body comprises a cap. Regarding claim 15, Navas discloses a device wherein the cap includes a threaded inner region. Regarding claim 17, Navas discloses a device wherein the second dampening member includes a ring shape with an opening capable of receiving the first elongated body of the second rod portion. Regarding claim 18, Navas discloses a device wherein the opening in the second end of the cylindrical body portion includes a width that is less than a width of the enlarged end portion but is

greater than a width of the first elongated body capable of allowing the second rod portion to laterally bend with respect to the cylindrical body portion.

Regarding claim 13, Navas discloses the invention as claimed except for the first dampening element and the second dampening element each include at least one inclined face. Clayton Jr. teaches a device comprising a first dampening element and a second dampening element, wherein each of the dampening elements includes at least one inclined face in order to help transfer heat from the device caused by friction (column 4 lines 30-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Navas wherein each of the dampening elements include at least one inclined face in view of Clayton Jr. in order to help transfer heat from the device caused by friction.

Figure 1



5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674) further in view of Alby (U.S. Patent 6,241,730).

Regarding claim 16, the combination of Navas and Clayton Jr. disclose the invention as claimed except for the first rod portion including a threaded end capable of engaging a threaded portion of the cylindrical body portion. Alby teaches a device comprising a first rod portion (4a) including a threaded end (15) capable of engaging a threaded portion (13) of a cylindrical body (4) in order to allow the cylindrical body to be connected to various elements having different lengths and/or shapes (column 4 lines 35-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the combination of Navas and Clayton Jr. wherein the first rod portion includes a threaded end capable of engaging a threaded portion of the cylindrical body in view of Alby in order to allow the cylindrical body to be connected to various element having different lengths and/or shapes.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674) further in view of Belogour (U.S. Patent 5,503,413).

The device of Navas as modified by Clayton Jr. discloses the invention was claimed except for the opening having an oblong shape. Belogour teaches a device comprising a shock absorbing element having a rod passing through an oblong opening (38) in order to allow full compression of the shock absorbing element at an angle (column 4 lines 1-7). It would have been obvious to one having ordinary skill in the art at

the time the invention was made to provide the device of Navas as modified by Clayton Jr. to further include an oblong opening in view of Belogour in order to allow full compression of the device at an angle.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Navas (U.S. Patent 5,375,823) in view of Clayton Jr. (U.S. Patent 4,445,674) further in view of Morrow (U.S. Patent 6,382,602).

The device of Navas as modified by Clayton Jr. discloses the invention as claimed except for the opening being eccentrically positioned on the second end of the device. Morrow teaches a shock absorbing device comprising rods, for example element 9, and openings (see Figure 2) that accept the rods, wherein the openings are eccentrically located on the ends of the device in order to compensate for transverse loading of the rods (column 1 lines 25-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Navas as modified by Clayton Jr. wherein the opening and the rods are eccentrically located relative to the axis of the device in view of Morrow in order to compensate for transverse loading of the rods.

#### ***Response to Arguments***

8. Applicant's arguments, see applicant's arguments, filed 10/17/2008, with respect to the rejection(s) of claim(s) 19 and 20 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Belogour

reference and the Morrow reference. The examiner has provided new grounds of rejection not necessitated by the amendment making this office action non-final.

9. Applicant's arguments filed 10/17/2008 directed to the restriction requirement and claims 13-18 have been fully considered but they are not persuasive. The applicant's argument that the restriction of claims 21-27 is improper is not persuasive. As clearly stated in the MPEP and outlined by 37 CFR 1.145, "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § 1.143 and 1.144". The inventions are independent because the method does not require all the limitations of the apparatus, i.e. the apparatus has specific limitation directed to the positioning of the first dampening member and the method claim does not require this limitation, therefore the method can be performed by another materially different apparatus making the inventions independent and distinct and the restriction of the inventions proper. The applicant's argument that the combination of Navas in view of Clayton Jr. fails to support a prima facie case of obviousness is not proper. First the applicant argues that the Clayton Jr. reference is directed to a problem that has absolutely no relevance to spinal implants making the rejection improper, i.e. heat dissipation, that the references are not analogous, and that there is no motivation to use the teachings of the Clayton Jr. reference to modify the Navas reference. The examiner will provide a section MPEP 2141 to reply to the applicant's arguments. MPEP 2141 states, "Office personnel should



continue to follow the general search guidelines set forth in MPEP § 904 to § 904.03 regarding search of the prior art. Office personnel are reminded that, for purposes of 35 U.S.C. 103, prior art can be either in the field of applicant's endeavor or be reasonably pertinent to the particular problem with which the applicant was concerned.

Furthermore, prior art that is in a field of endeavor other than that of the applicant (as noted by the Court in KSR, "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one", 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (emphasis added)), or solves a problem which is different from that which the applicant was trying to solve, may also be considered for the purposes of 35 U.S.C. 103. (The Court in KSR stated that "[t]he first error...in this case was...holding that courts and patent examiners should look only to the problem the patentee was trying to solve. The Court of Appeals failed to recognize that the problem motivating the patentee may be only one of many addressed by the patent's subject matter...The second error [was]...that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." 550 U.S. at \_\_\_, 82 USPQ2d at 1397. Federal Circuit case law prior to the Supreme Court's decision in KSR is generally in accord with these statements by the KSR Court. See e.g., *In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1902 (Fed. Cir. 1990) (en banc) ("[ I ]t is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or

composition will have the same or a similar utility as one newly discovered by applicant"); In re Lintner, 458 F.2d 1013, 1018, 173 USPQ 560, 562 (CCPA 1972) ("The fact that [applicant] uses sugar for a different purpose does not alter the conclusion that its use in a prior art composition would be prima facie obvious from the purpose disclosed in the references.")). KSR clearly states that the references do not need to be in the same field of endeavor, but can also be in an area that solves reasonably pertinent problems with which the applicant was concerned, i.e. the applicant's invention is directed to a shock absorbing device capable of being used on the spine and the Clayton Jr. reference is directed to shock absorbing device capable of being used on a rig. Therefore, since both references are directed to shock absorbing devices, the examiner believes that the references are analogous. The applicant's argument that the Navas reference does not disclose a problem with heat dissipation and that the problem is not encountered in spinal implants, which leads to no suggestion to combine the teachings of the references is not persuasive. As clearly discussed by the KSR decision, the prior art references do not need to be directed to solving a similar problem nor do the references need to solve the same problem as the applicant. Therefore, the examiner believes the combination of references is proper and the rejection is proper. The applicant's argument that there is no motivation to combine the Navas reference and the teachings of the Clayton Jr. reference is not persuasive. The Clayton Jr. reference clearly states that providing the inclined faces on the compression elements help provide better heat dissipation.

**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
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